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DATE: November 13, 2006

TO: Examiner BASHORE, William L. **FAX NO.:** 571-273-8300
USPTO GPAU 2176

FROM: Jeffrey G. Toler
Reg. No.: 38,342

RE U.S. App. No.: 10/602,010, filed June 23, 2003

Applicant(s): Bruce Edward Stuckman, et al.

Atty Dkt No.: 1033-T00531

Title: PATENT INFRINGEMENT NOTIFICATION SITE

NO. OF PAGES (including Cover Sheet): 25

MESSAGE:

Attached please find:

☒ Transmittal Form (1 pg)
☒ Fee Transmittal (in duplicate) (2 pgs)
☒ Brief in Support of Appeal (21 pgs)

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission: 25

Application Number	10/602,010
Filing Date	June 23, 2003
First Named Inventor	Bruce Edward Stuckman, et al.
Art Unit	2176
Examiner Name	BASHORE, William L.
Attorney Docket Number	1033-T00531

ENCLOSURES *(Check all that apply)*

- [x] Fee Transmittal Form
  - [ ] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Reply to Missing Parts/ Incomplete Application
  - [ ] Reply to Missing Parts under 37 CFR 1.52 or 1.53
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____
  - [ ] Landscape Table on CD
- [ ] After Allowance Communication to TC
- [ ] Appeal Communication to Board of Appeals and Interferences
- [x] Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
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Firm Name	Toler Schaffer, LLP		
Signature			
Printed name	Jeffrey G. Toler		
Date	11-13-2006	Reg. No.	38,342

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FEE TRANSMITTAL
For FY 2006

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 500.00

Complete if Known	
Application Number	10/602,010
Filing Date	June 23, 2003
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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES Fee ($)	FILING FEES Small Entity Fee ($)	SEARCH FEES Fee ($)	SEARCH FEES Small Entity Fee ($)	EXAMINATION FEES Fee ($)	EXAMINATION FEES Small Entity Fee ($)	Fees Paid ($)
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee ($)	Small Entity Fee ($)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims _____ - 20 or HP = _____ x _____ = _____ Fee Paid ($)

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims _____ - 3 or HP = _____ x _____ = _____ Fee Paid ($)

HP = highest number of independent claims paid for, if greater than 3.

Multiple Dependent Claims: Fee ($) _____ Fee Paid ($) _____

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(c)), the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets _____ - 100 = _____ Extra Sheets / 50 = _____ Number of each additional 50 or fraction thereof (round up to a whole number) x _____ Fee ($) = _____ Fee Paid ($)

4. OTHER FEE(S)

	Fees Paid ($)
Non-English Specification, $130 fee (no small entity discount)	
Other (e.g., late filing surcharge): Brief In Support of Appeal Filing Fee	500.00

SUBMITTED BY

Signature		Registration No. (Attorney/Agent) 38,342	Telephone 512/327-5515
Name (Print/Type)	Jeffrey G. Toler		Date 11-13-2006

Attorney Docket No.: 1033-T00531

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	**Bruce Edward Stuckman, et al.**		
Title:	**PATENT INFRINGEMENT NOTIFICATION SITE**		
App. No.:	**10/602,010**	Filed:	**June 23, 2003**
Examiner:	**BASHORE, William L.**	Group Art Unit:	**2176**
Atty. Dkt. No.:	**1033-T00531**	Confirmation No.:	**7678**

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BRIEF IN SUPPORT OF APPEAL

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I. REAL PARTY IN INTEREST (37 C.F.R. § 41.37(c)(1)(i))

The Real Party in Interest in the present Appeal is **SBC Knowledge Ventures, L.P.**, the assignee, of Patent Application No. **10/602,010**, as evidenced by the assignment set forth at Reel **014030**, Frame **0206**.

II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 41.37(c)(1)(ii))

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal, Appellant is not aware of any such appeals or interferences.

III. STATUS OF CLAIMS (37 C.F.R. § 41.37(c)(1)(iii))

A. Total Number of Claims in Application

There are 34 claims pending in the application (claims 1-7, 9-22 and 24-36).

B. Status of All the Claims

Claims 1, 24, and 36 are independent claims. According to paragraphs 3 and 4 of the Final Office Action dated July 27, 2006, the Examiner states that claims 1-7, 9-22, and 24-36 stand rejected, and are hereby appealed. Claims 8 and 23 were canceled in the Response to Non-Final Office Action filed on May 4, 2006.

C. Claims on Appeal

There are 34 claims on appeal (claims 1-7, 9-22 and 24-36).

IV. STATUS OF AMENDMENTS (37 C.F.R. § 41.37(c)(1)(iv))

The claims hereby appealed are based on the Amendment filed May 4, 2006. No amendment was offered or entered after the Final Office Action.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER (37 C.F.R. § 41.37(c)(1)(v))

The subject matter of Claim 1 can be summarized as follows:

A method is disclosed that includes posting an electronic form which displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria.

Claim 1 finds support from at least Figures 1-4, page 2, paragraph [1009], and page 3, paragraph [1011] through page 7, paragraph [1030] of the specification.

The subject matter of Claim 24 can be summarized as follows:

An article is disclosed that includes a computer-readable medium having stored thereon an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria.

Claim 24 finds support from at least Figures 2-4, page 2, paragraph [1009], and page 3, paragraph [1011] through page 7, paragraph [1030] of the specification

The subject matter of Claim 36 can be summarized as follows:

A method is disclosed that includes posting an electronic form which displays criteria for infringement of a particular patent and accepts first user input to identify infringement target information and second user input to describe how the infringement target meets the criteria, where the infringement target information does not pre-date the filing date of the particular patent. The method further includes receiving an infringement submission made via the electronic form and evaluating the infringement submission based on the first user input and the second user input.

Claim 36 finds support from at least Figures 1-4, page 2, paragraph [1009], and page 3, paragraph [1011] through page 7, paragraph [1030] of the specification.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. § 41.37(c)(1)(vi))

A. Claims 1-7 and 9-22 are rejected under 35 U.S.C. 103(a) as being anticipated over European Patent No. 1,160,708 A1 ("Utsumi") in view of www.BountyQuest.com ("the BountyQuest website") at page 2, paragraphs 3 and 4 of the Final Office Action.

B. Claims 24-35 are rejected under 35 U.S.C. 103(a) as being anticipated over Utsumi in view of the BountyQuest website at page 2, paragraphs 3 and 4 of the Final Office Action.

C. Claim 36 is rejected under 35 U.S.C. 103(a) as being anticipated over Utsumi in view of the BountyQuest website at page 2, paragraphs 3 and 4 of the Final Office Action.

VII. ARGUMENT (37 C.F.R. § 41.37(c)(1)(vii))

Appellant respectfully appeals each of the rejections applied against all claims now pending.

A. CLAIMS 1-7 AND 9-22 ARE ALLOWABLE OVER UTSUMI IN VIEW OF THE BOUNTYQUEST WEBSITE

Appellant traverses the rejection of claims 1-7 and 9-22 under 35 U.S.C. 103(a) over European Patent No. 1,160,708 A1 ("Utsumi") in view of www.BountyQuest.com ("the BountyQuest website") at page 2, paragraphs 3 and 4 of the Final Office Action.

1. The Asserted Combination of Utsumi and the BountyQuest Website Does Not Disclose Every Element of Each of the Claims 1-7 and 9-22.

The asserted combination of Utsumi and the BountyQuest website fails to disclose or suggest an electronic form which displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited by claim 1.

Utsumi discloses a system that solicits information about products that may infringe a right-holder's patents, trademarks, or copyrights. *See Utsumi*, Abstract and col. 3, paragraph [0017]. Utsumi discloses a website to receive input to identify possible infringers, including three text inputs: an email address input window, an account number input window to provide an account number to receive payment, and a detailed information input window to receive detailed information about an infringer. *See Utsumi*, Figure 3 and col. 5, paragraph [0030].

The Final Office Action states:

> Utsumi teaches an input form field for inputting detailed infringement information (Utsumi, para [0030] window 23). Said window 23 is offered for input of infringement target information, with the size of said window providing the capability of inputting as much information as may be necessary.

See Final Office Action, p. 3, paragraph 4.

Utsumi discloses that the detailed information window may be used by an information provider to express "his willingness to provide information" or to provide "the information itself." *See Utsumi*, col. 5, paragraph [0030]. Nonetheless, Utsumi still discloses only one input to receive information related to the patent number displayed on the form. *See Utsumi*, Figure 3. Utsumi fails to disclose or suggest a second user input to describe how an infringement target meets infringement criteria, as recited by independent claim 1.

Additionally, the Final Office Action states:

> It is also noted that Figure 3 "Patent Number" (upper left corner) is carried over from Utsumi Figure 2 item 15, at least providing criteria for infringement via at least the display of the patent number itself on the form of Figure 3.

See Final Office Action, p. 3, paragraph 4.

Appellant notes that the patent number identifies a particular patent, but the patent number alone does not provide "criteria for infringement." The claims define the legal scope of a patent, and infringement of a patent claim under 35 U.S.C. § 271 requires that the elements of a claim (or equivalents thereof) must be present in the accused apparatus or method to infringe the patent. Accordingly, such "criteria for infringement" constitutes something more than a patent number. Thus, Utsumi fails to disclose or suggest providing an electronic form which displays criteria for infringement of a particular patent, as recited by independent claim 1.

In view of the foregoing, Utsumi fails to disclose or suggest an electronic form which displays **criteria for infringement** of a particular patent and accepts first user input to identify an infringement target and **second user input to describe how the infringement target meets the criteria**, as recited by claim 1.

The Final Office Action acknowledges:

> Utsumi does not specifically teach a second user input to describe how said target meets the criteria, or of [sic] indication of an infringement target.

Final Office Action, p. 3, paragraph 4.

The Final Office Action asserts that the BountyQuest website "teaches an input form for a user to enter information, including multiple areas for describing how the infringement target meets the criteria (BountyQuest, page 16 section 'Required Elements')." *See Final Office Action*, p. 3, paragraph 4. However, the BountyQuest website does not disclose the features of claim 1 that are not disclosed by Utsumi.

For example, the BountyQuest website is directed to identifying invalidating prior art, not potential infringers. *See the BountyQuest website*, p. 9. The BountyQuest website discloses that a "hunter" wins a bounty (e.g., a cash reward) by being the first to submit a single document to

invalidate a particular patent. *See the BountyQuest website*, pp. 13-14 ("Does a winning submission have to invalidate the patent in question."). The "Required Elements" shown at page 16 include claim elements; however, the BountyQuest website displays "criteria for invalidity," not "criteria for infringement," as recited by independent claim 1.

Moreover, the corresponding text input adjacent to the "criteria for invalidity" receives information identifying page numbers within a prior art submission that anticipate the required element(s) of a particular claim. *See the BountyQuest website*, p. 16. Not only does the BountyQuest website fail to display "criteria for infringement" and text inputs to identify an infringing target (e.g., an infringer and a product or element of a product that infringes the criteria for infringement), but the BountyQuest website displays the opposite information, namely criteria for invalidity and text inputs to invalidate the claims (e.g, a prior art reference input and inputs to receive particular pages within the prior art reference to invalidate a patent claim). The BountyQuest website does not disclose or suggest a "first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria," as recited by independent claim 1.

Thus, the asserted combination of Utsumi and the BountyQuest website fails to disclose or suggest an electronic form which displays **criteria for infringement** of a particular patent and accepts first user input to identify an infringement target and **second user input to describe how the infringement target meets the criteria**, as recited by independent claim 1. As a result, the asserted combination of Utsumi and the BountyQuest website fails to disclose or suggest at least one element of each of the claims 2-7 and 9-22, at least by virtue of their dependency from independent claim 1.

2. There Is No Motivation to Combine Utsumi with the BountyQuest Website.

The Final Office Action fails to establish a *prima facie* case of obviousness. A *prima facie* case of obviousness requires a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The asserted combination of Utsumi and the BountyQuest website fails to disclose or suggest a motivation to modify Utsumi to include the teachings of the BountyQuest website. "[I]t is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves." *In re Wright*, 848 F.2d 1216, 6 USPQ2d 1959 (Fed. Cir. 1988). Utsumi discloses a system to solicit information from third parties to identify potential infringers of intellectual property rights and to reimburse a third party for contributing such information. *See Utsumi*, Abstract. The BountyQuest website discloses a system to solicit information from third parties to invalidate patents and to reimburse a third party for being the first to contribute such prior art information. *See the BountyQuest website*, p. 3. It would not have been obvious to modify the infringer identification system of Utsumi to include the teachings of the prior art solicitation system of the BountyQuest website because they solve different problems (identifying infringers of a patent versus identifying prior art to invalidate a patent).

Moreover, the infringer identification system of Utsumi teaches away from the prior art solicitation system of the BountyQuest website. The infringer identification system of Utsumi is directed to enforcement of intellectual property rights, while the prior art solicitation system of the BountyQuest website is directed to preventing enforcement of intellectual property rights. "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor." ATD Corp. v. Lydall, Inc., 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998). The asserted combination of Utsumi and the BountyQuest website selectively ignores the teachings of the BountyQuest website to make the combination, improperly equating a text input to receive a page number of a prior art reference to invalidate a claim with "a second input to describe how the infringement target meets the criteria."

Further, soliciting invalidating prior art information (as taught by the BountyQuest website) frustrates the purpose of the infringer identification system of Utsumi, namely to

identify patent infringers (as taught by Utsumi). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Modifying the patent infringer identification system of Utsumi to include the invalidating prior art solicitation system of the BountyQuest website would render the infringer identification system of Utsumi unsatisfactory for its intended purpose, since the identification of invalidating prior art (as taught by the BountyQuest website) would undermine the enforcement effort associated with infringer identification (Utsumi). Accordingly, there exists no suggestion or motivation to make the proposed combination.

The Final Office Action asserted a secondary motivation for modifying the infringer identification system of Utsumi to include the prior art solicitation system of the BountyQuest website, at page 8, paragraph 5. The Final Office Action asserts that since the cost of patent litigation is high, it would be obvious to solicit both potential infringer information and patent invalidity information for the same patent on the same web site, so that a patent holder can avoid the expense of patent litigation of an issued patent that may be found invalid over a prior art reference. *See Final Office Action*, p. 8, paragraph 5.

This suggested motivation for combining the infringer identification system of Utsumi with the prior art solicitation system of the BountyQuest website is without support in the references. The BountyQuest website discloses that venture capital firms might use the BountyQuest website to assess the validity of patents owned by other companies in which they might invest. *See the BountyQuest website*, p. 9, top paragraph. The BountyQuest website makes no mention of a company wishing to identify prior art to invalidate its own patents, as suggested by the Final Office Action.

For at least the foregoing reasons, the asserted combination of Utsumi and the BountyQuest website constitutes an impermissible hindsight reconstruction based on the present application, and the rejection of claims 1-7 and 9-22 should be withdrawn.

B. CLAIMS 24-35 ARE ALLOWABLE OVER UTSUMI IN VIEW OF THE BOUNTYQUEST WEBSITE

Appellant traverses the rejection of claims 24-35 under 35 U.S.C. 103(a) over Utsumi in view of the BountyQuest website at page 2, paragraphs 3 and 4, of the Final Office Action.

1. The Asserted Combination of Utsumi and the BountyQuest website Does Not Disclose Every Element of Each of the Claims 24-35.

Claim 24 recites an article including a computer-readable medium having stored thereon an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria. The asserted combination of Utsumi and the BountyQuest website fails to disclose or suggest an electronic form which displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria, as recited by independent claim 24.

As explained above, Utsumi discloses a system that solicits information about products that may infringe a right-holder's patents, trademarks, or copyrights. *See Utsumi*, Abstract and col. 3, paragraph [0017]. Utsumi discloses that a detailed information window that may be used by an information provider to express "his willingness to provide [infringement] information" or to provide "the information itself." *See Utsumi*, col. 5, paragraph [0030]. Utsumi discloses only one input to receive information related to the patent number displayed on the form. *See Utsumi*, Figure 3. Thus, Utsumi fails to disclose or suggest a second user input to describe how the infringement target meets the criteria, as recited by independent claim 24. Additionally, as discussed above, the "criteria for infringement" constitutes something more than the patent number alone. Thus, Utsumi fails to disclose or suggest providing an electronic form which displays criteria for infringement of a particular patent, as recited by independent claim 24.

Thus, Utsumi fails to disclose or suggest a computer-readable medium having stored thereon an electronic form to display **criteria for infringement** of a particular patent and to accept first user input to identify an infringement target and **second user input to describe how the infringement target meets the criteria**, as recited by claim 24.

In addition, the BountyQuest website fails to disclose or suggest the elements of claim 24 not disclosed by Utsumi. The BountyQuest website is directed to identifying invalidating prior art, not potential infringers. *See the BountyQuest website*, p. 9. The BountyQuest website discloses that a "hunter" wins a bounty (e.g., a cash reward) by being the first to submit a single document to invalidate a particular patent. *See the BountyQuest website*, pp. 13-14 ("Does a winning submission have to invalidate the patent in question."). The "Required Elements" shown at page 16 include claim elements; however, the BountyQuest website displays "criteria for invalidity," not "criteria for infringement" as recited by independent claim 24.

Moreover, the corresponding text input adjacent to the "criteria for invalidity" receives information identifying page numbers within a prior art submission that anticipate the required element of the particular claim. *See the BountyQuest website*, p. 16. Not only does the BountyQuest website fail to display "criteria for infringement," but the BountyQuest website displays the opposite information, namely criteria for invalidity (e.g, a prior art reference and particular pages within the prior art reference to invalidate a patent claim). The BountyQuest website does not disclose or suggest a "first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria," as recited by independent claim 24.

Thus, the asserted combination of Utsumi and the BountyQuest website fails to disclose or suggest a computer-readable medium having stored thereon an electronic form to display **criteria for infringement** of a particular patent and to accept first user input to identify an infringement target and **second user input to describe how the infringement target meets the criteria**, as recited by independent claim 24. Thus, the asserted combination of Utsumi and the BountyQuest website fails to disclose or suggest at least one element of each of the claims 25-35, at least by virtue of their dependency from independent claim 24.

2. There Is No Motivation to Combine Utsumi with the BountyQuest Website.

As discussed above with respect to claim 1, the infringer identification system of Utsumi teaches away from the prior art solicitation system of the BountyQuest website. Moreover, the purported bases for modifying the infringer identification system of Utsumi with the prior art solicitation system of the BountyQuest website lack support in the references and selectively ignore aspects of the cited references. The asserted combination constitutes an impermissible

hindsight reconstruction based on the present application. Accordingly, there is no motivation to make the asserted combination. The rejection of claims 24-35 over the combination of Utsumi and the BountyQuest website should be withdrawn.

C. CLAIM 36 IS ALLOWABLE OVER UTSUMI IN VIEW OF THE BOUNTYQUEST WEBSITE

Appellant traverses the rejection of claim 36 under 35 U.S.C. 103(a) over Utsumi in view of the BountyQuest website at page 2, paragraphs 3 and 4, of the Final Office Action.

1. The Asserted Combination of Utsumi and the BountyQuest Website Does Not Disclose Every Element of Claim 36.

Claim 36 recites a method that includes posting an electronic form which displays criteria for infringement of a particular patent and accepts first user input to identify infringement target information and second user input to describe how the infringement target meets the criteria, where the infringement target information does not predate the filing date of the particular patent. The method further includes receiving an infringement submission made via the electronic form and evaluating the infringement submission based on the first user input and the second user input. The asserted combination of Utsumi and the BountyQuest website fails to disclose or suggest a second user input to describe how the infringement target meets the criteria, wherein the infringement target information does not pre-date the filing date of the particular patent, as recited by independent claim 36.

As explained above, Utsumi discloses a system that solicits information about products that may infringe a right-holder's patents, trademarks, or copyrights. *See Utsumi*, Abstract and col. 3, paragraph [0017]. Utsumi discloses that a detailed information window that may be used by an information provider to express "his willingness to provide [infringement] information" or to provide "the information itself." *See Utsumi*, col. 5, paragraph [0030]. Utsumi discloses only one input to receive information related to the patent number displayed on the form. *See Utsumi*, Figure 3. Thus, Utsumi fails to disclose or suggest a second user input to describe how the infringement target meets the criteria, as recited by independent claim 24. Additionally, as discussed above, the "criteria for infringement" constitutes something more than the patent

number alone. Thus, Utsumi fails to disclose or suggest providing an electronic form which displays criteria for infringement of a particular patent, as recited by independent claim 24.

Thus, Utsumi fails to disclose or suggest posting an electronic form which displays **criteria for infringement** of a particular patent and accepts first user input to identify infringement target information and **second user input to describe how the infringement target meets the criteria**, where the infringement target information does not predate the filing date of the particular patent, as recited by claim 36.

In addition, the BountyQuest website fails to disclose or suggest the elements of claim 36 not disclosed by Utsumi. The BountyQuest website is directed to identifying invalidating prior art, not potential infringers. *See the BountyQuest website*, p. 9. The BountyQuest website discloses that a "hunter" wins a bounty (e.g., a cash reward) by being the first to submit a single document to invalidate a particular patent. *See the BountyQuest website*, pp. 13-14 ("Does a winning submission have to invalidate the patent in question."). The "Required Elements" shown at page 16 include claim elements; however, the BountyQuest website displays "criteria for invalidity," not "criteria for infringement" as recited by independent claim 36.

Moreover, the corresponding text input adjacent to the "criteria for invalidity" receives information identifying page numbers within a prior art submission that anticipate the required element of the particular claim. *See the BountyQuest website*, p. 16. Not only does the BountyQuest website fail to display "criteria for infringement," but the BountyQuest website displays the opposite information, namely criteria for invalidity (e.g, a prior art reference and particular pages within the prior art reference to invalidate a patent claim). The BountyQuest website does not disclose or suggest a "first user input to identifying an infringement target and second user input to describe how the infringement target meets the criteria," as recited by independent claim 36.

Thus, the asserted combination of Utsumi and the BountyQuest website fails to disclose or suggest a computer-readable medium having stored thereon an electronic form to display **criteria for infringement** of a particular patent and to accept first user input to identify an infringement target and **second user input to describe how the infringement target meets the criteria**, as recited by independent claim 36.

2. There Is No Motivation to Combine Utsumi with the BountyQuest Website.

As discussed above with respect to claim 1, the target infringer identifying system of Utsumi teaches away from the prior art invalidity system of the BountyQuest website. Moreover, the purported bases for modifying Utsumi with the teachings of the BountyQuest website lack support in the references and selectively ignore aspects of the cited references. The asserted combination constitutes an impermissible hindsight reconstruction based on the present application. Accordingly, there is no motivation to make the asserted combination. The rejection of claim 36 over the combination of Utsumi and the BountyQuest website should be withdrawn.

In addition, Appellant notes that claim 36 recites "wherein the infringement target information **does not pre-date** the filing date of the particular patent." The BountyQuest website explicitly seeks prior art information (e.g., information related to a document that predates the filing date of the particular patent), while the Utsumi reference seeks information related to an infringer. The language of claim 36 highlights that the infringer identification system of Utsumi teaches away from the prior art solicitation system of the BountyQuest website. Moreover, the BountyQuest website teaches away from the language of claim 36, by **specifically seeking information that pre-dates a filing date** of a particular patent. There is no motivation to make the asserted combination, except for the motivation provided by the present application. Therefore, the asserted combination of Utsumi and the BountyQuest website is an impermissible hindsight reconstruction based on the present application. The rejection of claim 36 over the asserted combination of Utsumi and the BountyQuest website should be withdrawn.

For at least the foregoing reasons, Appellant respectfully submits that the present application is in condition for allowance and reconsideration is respectfully requested.

VIII. CLAIMS APPENDIX (37 C.F.R. § 41.37(c)(1)(viii))

The text of each claim involved in the appeal is as follows:

1. (Original) A method comprising:

posting an electronic form which displays criteria for infringement of a particular patent and accepts first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria.

2. (Original) The method of claim 1 wherein the electronic form comprises a plurality of input boxes to accept the second user input.

3. (Original) The method of claim 2 wherein each of the plurality input boxes is associated with a respective one of the criteria.

4. (Original) The method of claim 2 wherein the electronic form has a plurality of display portions each to display a respective one of the criteria, and wherein each of the plurality of input boxes is positioned adjacent to one of the plurality of display portions to receive a portion of the second user input which describes how the infringement target meets the respective one of the criteria.

5. (Original) The method of claim 4 wherein the display portions are arranged in a first column of the electronic form, and wherein the input boxes are arranged in a second column of the electronic form.

6. (Original) The method of claim 4 wherein the criteria comprises a plurality of claim limitations, and wherein each of the claim limitations is associated with one of the plurality of display portions is associated with one of the plurality of input boxes.

7. (Original) The method of claim 2 wherein the electronic form comprises an input box to accept the first user input.

8. (Cancelled)

9. (Original) The method of claim 1 wherein the electronic form comprises a Web form.

10. (Original) The method of claim 1 wherein the infringement target is identified by a product name in the first user input.

11. (Original) The method of claim 1 wherein the infringement target is identified by a company name in the first user input.

12. (Original) The method of claim 1 further comprising:

receiving an infringement submission made by a user via the electronic form; and

evaluating the infringement submission based on the first user input and the second user input.

13. (Original) The method of claim 12 wherein said evaluating is performed by a patent attorney.

14. (Original) The method of claim 12 further comprising:

compensating the user if the infringement submission is evaluated to be a first-received on-point submission for the infringement target.

15. (Original) The method of claim 14 wherein said compensating the user is conditioned on a deal with the infringement target.

16. (Original) The method of claim 14 wherein said compensating the user comprises providing the user a fixed fee.

17. (Original) The method of claim 14 wherein said compensating the user comprises providing the user a fee commensurate with compensation from a deal with the infringement target.

18. (Original) The method of claim 12 further comprising:

recording a date and a time associated with the infringement submission.

19. (Original) The method of claim 18 further comprising:

sending, to the user, a message to acknowledge receipt of the infringement submission, the message indicating the date and the time associated with the infringement submission.

20. (Original) The method of claim 1 wherein the electronic form is posted on an intranet.

21. (Original) The method of claim 1 wherein the electronic form is posted on the Internet.

22. (Original) The method of claim 1 wherein the second user input comprises graphical input.

23. (Cancelled)

24. (Original) An article comprising:

a computer-readable medium having stored thereon an electronic form to display criteria for infringement of a particular patent and to accept first user input to identify an infringement target and second user input to describe how the infringement target meets the criteria.

25. (Original) The article of claim 24 wherein the electronic form comprises a plurality of input boxes to accept the second user input.

26. (Original) The article of claim 25 wherein each of the plurality of input boxes is associated with a respective one of the criteria.

27. (Original) The article of claim 25 wherein the electronic form has a plurality of display portions each to display a respective one of the criteria, and wherein each of the plurality of input boxes is adjacent to one of the plurality of display portions to receive a portion of the second input that describes how the infringement target meets the respective one of the criteria.

28. (Original) The article of claim 27 wherein the plurality of display portions are arranged in a first column of the electronic form, and wherein the plurality of input boxes are arranged in a second column of the electronic form.

29. (Original) The article of claim 27 wherein the criteria comprises a plurality of claim limitations, and wherein each of the claim limitations has an associated one of the plurality of display portions and an associated one of the plurality of input boxes.

30. (Original) The article of claim 25 wherein the electronic form comprises an input box to accept the first user input.

31. (Original) The article of claim 25 wherein each of the plurality of input boxes is to receive natural language textual input.

32. (Original) The article of claim 24 wherein the electronic form comprises a Web form.

33. (Original) The article of claim 24 wherein the second user input comprises graphical input.

34. (Original) The article of claim 24 wherein the criteria is translated from a first language to a second language.

35. (Previously Presented) The method of claim 12 further comprising:

providing a trust mechanism to discourage a user from providing a non-useful infringement submission.

36. (Previously Presented) A method comprising:

posting an electronic form which displays criteria for infringement of a particular patent and accepts first user input to identify infringement target information and second user input to describe how the infringement target meets the criteria, wherein the infringement target information does not predate the filing date of the particular patent;

receiving an infringement submission made via the electronic form; and

evaluating the infringement submission based on the first user input and the second user input.

IX. EVIDENCE APPENDIX (37 C.F.R. § 41.37(c)(1)(ix))

(N/A)

X. RELATED PROCEEDINGS APPENDIX (37 C.F.R. § 41.37(c)(1)(x))

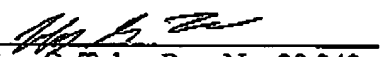
(N/A)

XI. CONCLUSION

For at least the above reasons, all pending claims are allowable and a notice of allowance is courteously solicited. Please direct any questions or comments to the undersigned attorney at the address indicated. Appellant respectfully requests reconsideration and allowance of all claims and that this patent application be passed to issue.

Respectfully submitted,

11-13-2006
Date



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